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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/676,078	Applicant(s) BOHAN, DAVID	
	Examiner Qamrun Nahar	Art Unit 2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 28-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-25 and 28-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 7/9/04.
2. The objection to claim 27 is withdrawn in view of applicant's amendment.
3. The objection to claim 30 is withdrawn in view of applicant's amendment.
4. The rejection under 35 U.S.C. 101 to claims 28-30 is withdrawn in view of applicant's amendment.
5. Claims 26-27 have been cancelled.
6. Claims 8, 21-25 and 28-30 have been amended.
7. Claims 1-25 and 28-30 are pending.
8. The objection to claim 22 is pending.
9. Claims 21-24 stand finally rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
10. Claims 1-4, 8-10, 14-17, 21-25 and 28-30 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB).
11. Claims 5, 11 and 18 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB) in view of Tsukamoto (U.S. 5,857,073).
12. Claims 6, 12 and 19 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over "Web390 for OS/390 and MVS", Information Builders, Inc., 1999 (hereinafter IB) in view of Sampath (U.S. 6,266,774).

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13. Claims 7, 13 and 20 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB) in view of Gottsman (U.S. 6,134,548).

Response to Amendment

Claim Objections

14. Claim 22 is objected to because of the following informalities: “cal” on line 10 of the claim should be “call”. Appropriate correction is required.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 21, the claim must not be directed merely to an abstract idea, but must instead be tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful and tangible result. Abstract ideas, **Warmerdam**, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, **Schrader**, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. See MPEP § 2106(IV)(B)(1)(a).

It is suggested that claim 21 be amended to include an additional step, where the indication whether or not the third party legacy data list is available is used.

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As per claims 22-24, these claims are rejected for dependency on the above rejected non-statutory claim 21.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1-4, 8-10, 14-17, 21-25 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB).

Per Claim 1:

The IB publication discloses:

- **a method of providing an access to one or more third party legacy data list to a user of an application program of a computer system (“Web390 for OS/390 and MVS ... Access Legacy Data and 3270 Applications From the Web” in Title and pg. 1, par. 1, lines 1-14)**
- **querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating**

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system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list; receiving, from said one or more plug-in modules found in said registry, identifications of one or more third party legacy data list corresponding to said found one or more plug-in modules; and providing a list of said identifications to said user through a user interface of said application program

("Users can choose one of several presentation options at runtime. Those familiar with 3270 terminals but new to the Web can select 3270 Emulation Mode, which employs a Netscape Navigator plug-in to deliver the familiar 3270 green screens to the browser windows. Those familiar with the Web can select HTML Translation Mode, which automatically converts 3270 datastreams into HTML forms, allowing users to interact using familiar radio buttons and scrolling data entry windows." on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6; inherently teaches querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system. Datastreams is interpreted as data list.).

Per Claim 2:

The IB publication discloses:

- adding to said computer system one or more additional plug-in module capable of interfacing with one or more additional third party legacy data list; and registering said one or more additional plug-in modules in said registry of said operating system, said application program being configured to find said one or more additional plug-in modules

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when said application program is started after said addition of said one or more additional plug-in modules (on pg. 2, par. 1, lines 1-6).

Per Claim 3:

The IB publication discloses:

- allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and allowing said user to edit at least one datum of said selected one of said one or more third party legacy data list through an edit user interface of said selected one of said one or more third party legacy data list, said application program communicating with said selected one of said one or more third party data list through corresponding one of said one or more plug-in module (on pg. 2, par. 2, lines 1-9).

Per Claim 4:

The IB publication discloses:

- allowing said user to select a selected one of said one or more third party legacy data list from said list of identifications; and allowing said user to access at least one datum of said selected one of said one or more third party legacy data list through said user interface of said application program, said application program communicating with said selected to said one of said one or more third party legacy data list through corresponding one of said one or more plug-in module (on pg. 2, par. 2, lines 1-9).

Per Claim 8 (Amended):

This is a system version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by IB.

Per Claim 9:

This is a system version of the claimed method discussed above, claim 2, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “an installer software” (on pg. 3, par. 3, lines 7-8). Thus, accordingly, this claim is also anticipated by IB.

Per Claim 10:

The IB publication discloses:

- **said user interface is configured to allow said user to select a selected one of said one or more third party legacy data list** (on pg. 3, par. 1, lines 1-7).

Per Claims 14-17:

These are computer readable storage medium versions of the claimed method discussed above (claims 1-4, respectively), wherein all claim limitations also have been addressed and/or

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covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by IB.

Per Claim 21 (Amended):

The IB publication discloses:

- **a method of providing an application program with access to a third party legacy data list not supported by the application program** (“Web390 for OS/390 and MVS ... Access Legacy Data and 3270 Applications From the Web” in Title and pg. 1, par. 1, lines 1-14)
- **supplying a plug-in module capable of providing an interface between the application program and the third party legacy data list; the application program sending a request function call to the plug-in module; the plug-in module, in response to the request function call, returning an identification of the third party legacy data list; the application program sending an availability function call to the plug-in module; and the plug-in module, in response to the availability function call, indicating whether or not the third party legacy data list is available** (“Users can choose one of several presentation options at runtime. Those familiar with 3270 terminals but new to the Web can select 3270 Emulation Mode, which employs a Netscape Navigator plug-in to deliver the familiar 3270 green screens to the browser windows. Those familiar with the Web can select HTML Translation Mode, which automatically converts 3270 datastreams into HTML forms, allowing users to interact using

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familiar radio buttons and scrolling data entry windows.” on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6; and pg. 3, par. 1, lines 1-7).

Per Claim 22 (Amended):

The IB publication discloses:

- wherein: supplying, comprises supplying a plurality of plug-in modules each capable of providing an interface between the application program and a corresponding third party legacy data list; sending a request function call comprises the application program sending a request function call to each of the plug-in modules; returning an identification comprises each plug-in module, in response to the request function call, returning an identification of its corresponding third party legacy data list; sending an availability function call comprises the application program sending an availability function call to each of the plug-in modules; and indicating comprises each the plug-in module, in response to the availability function call, indicating whether or not its corresponding third party legacy data list is available (on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6; and pg. 3, par. 1, lines 1-7).

Per Claim 23 (Amended):

The IB publication discloses:

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- further comprising the application program displaying, if the third party legacy data list is available, at least an identification of the third party legacy data list in a user interface (on pg. 2, par. 2, lines 1-9; and pg. 3, par. 1, lines 1-7).

Per Claim 24 (Amended):

The IB publication discloses:

- further comprising the application interacting with the plug-in module to allowing a user to select, access, and modify the third party legacy data list (on pg. 2, par. 2, lines 1-9; and pg. 3, par. 1, lines 1-7).

Per Claim 25 (Amended):

This is a computer readable medium version of the claimed method discussed above, claim 21, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by IB.

Per Claims 28-30 (Amended):

These are plug-in module versions of the claimed method discussed above (claims 21-22 and 24, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by IB.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 5, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB) in view of Tsukamoto (U.S. 5,857,073).

Per Claim 5:

The rejection of claim 4 is incorporated, and further, IB does not explicitly teach that the application program comprises a facsimile software or the one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software.

Tsukamoto teaches that the application program comprises a facsimile software (column 4, lines 10-18) and the one or more third party legacy data list comprise one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software (column 5, lines 16-65; column 11, lines 14-16; and Fig. 5).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by IB to include that the application program comprises a facsimile software and the one or more third party legacy data list comprise

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one or more list of names and telephone numbers stored in a format that is not otherwise compatible with the application program using a legacy facsimile software using the teaching of Tsukamoto. The modification would be obvious because one of ordinary skill in the art would be motivated to update software components comprising contact information.

Per Claim 11:

This is a system version of the claimed method discussed above, claim 5, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Per Claim 18:

This is a computer readable storage medium version of the claimed method discussed above, claim 5, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

21. Claims 6, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB) in view of Sampath (U.S. 6,266,774).

Per Claim 6:

The rejection of claim 4 is incorporated, and further, IB does not explicitly teach that the application program comprises an e-mail software or the one or more third party legacy data list

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comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software. Sampath teaches that the application program comprises an e-mail software (column 4, lines 33-43) and the one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software (column 6, lines 15-18).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by IB to include that the application program comprises an e-mail software and the one or more third party legacy data list comprise one or more list of names and e-mail addresses stored in a format that is not otherwise compatible with the application program using a legacy e-mail software using the teaching of Sampath. The modification would be obvious because one of ordinary skill in the art would be motivated to update software components comprising contact information.

Per Claim 12:

This is a system version of the claimed method discussed above, claim 6, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also obvious.

Per Claim 19:

This is a computer readable storage medium version of the claimed method discussed above, claim 6, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

22. Claims 7, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Web390 for OS/390 and MVS”, Information Builders, Inc., 1999 (hereinafter IB) in view of Gottsman (U.S. 6,134,548).

Per Claim 7:

The rejection of claim 4 is incorporated, and further, IB does not explicitly teach that the application program comprises a personal organizer software or the one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software. Gottsman teaches that the application program comprises a personal organizer software and the one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer software (column 37, lines 5-12).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by IB to include that the application program comprises a personal organizer software and the one or more third party legacy data list comprise one or more contact information and appointment information stored in a format that is not otherwise compatible with the application program using a legacy personal organizer

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software using the teaching of Gottsman. The modification would be obvious because one of ordinary skill in the art would be motivated to update software components comprising contact information.

Per Claim 13:

This is a system version of the claimed method discussed above, claim 7, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Per Claim 20:

This is a computer readable storage medium version of the claimed method discussed above, claim 7, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Response to Arguments

23. Applicant's arguments filed on 7/9/04 have been fully considered but they are not persuasive.

In the remarks, the applicant argues that:

a) Rejecting Claim 1, the Examiner cited ...

Nothing in the cited sections teaches querying an operating system registry for a plug-in capable of interfacing with a third party legacy data list as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable of interfacing with the IB web server.

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That web server plug-in is not capable of interfacing with a third party legacy data list as required by the first limitation above. Moreover nothing in the cited sections teaches or suggests receiving from a plug-in an identification of one or more third party legacy data lists let alone providing the such a list through a user interface of an application program as required by the second and third limitations above.

For these reasons, Claim 1 is felt to distinguish over IB. Claims 2-4 each depend from Claim 1 and include all of the limitations of that base claim. As such, Claims 2-4 are felt to distinguish over IB.

Examiner's response:

a) Examiner strongly disagrees with applicant's assertion that IB fails to disclose the claimed limitations recited in claim 1. IB shows each and every limitation in claim 1. As previously pointed out in the last Office Action (Mailed on 12/31/03) and currently maintained by the Examiner, IB teaches querying an operating system, by said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system, said one or more plug-in modules being capable of interfacing with corresponding respective ones of said one or more third party legacy data list; receiving, from said one or more plug-in modules found in said registry, identifications of one or more third party legacy data list corresponding to said found one or more plug-in modules; and providing a list of said identifications to said user through a user interface of said application program (on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6; inherently teaches querying an operating system, by

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said application program upon start of said application program, whether one or more plug-in module is registered in a registry of an operating system. Datastreams is interpreted as data list.)

In addition, see the rejection above in paragraph 18 for rejection to claims 1-4.

In the remarks, the applicant argues that:

b) The Examiner asserts that, for the same reasons Claim 1 is anticipated by IB, so is Claim 8. It is presumed then that the Examiner bases the rejection of Claim 8 on IB, page 1, paragraphs 1, 5, and 6. As pointed out above, nothing in these cited sections teaches a plug-in capable of interfacing with a third party legacy data list as required by the first limitation of Claim 8. Moreover, nothing in the cited sections teaches an application program capable of querying plug-in modules to identify third party legacy data lists let alone providing such a list through a user interface.

For these reasons, Claim 8 is felt to distinguish over IB, Claims 9 and 10 each depend from Claim 8 and include all of the limitations of that base claim. As such, Claims 9 and 10 are felt to distinguish over IB.

Examiner's response:

b) Examiner strongly disagrees with applicant's assertion that IB fails to disclose the claimed limitations recited in claim 8. IB shows each and every limitation in claim 8. The Examiner has already addressed the applicant's arguments in the Examiner's Response (a) above. In addition, see the rejection above in paragraph 18 for rejection to claims 8-10.

In the remarks, the applicant argues that:

c) The Examiner asserts that, for the same reasons Claim 1 is anticipated by IB, so is Claim 14. It is presumed then that the Examiner bases the rejection of Claim 14 on IB, page 1, paragraphs 1, 5, and 6. As pointed out above, nothing in these cited sections teaches a plug-in capable of interfacing with a third party legacy data list as required by the first limitation of Claim 8. Moreover, nothing in the cited sections teaches receiving from plug-in modules identifications of third party legacy data lists let alone providing such a list through a user interface.

For these reasons, Claim 14 is felt to distinguish over IB. Claims 15-17 each depend from Claim 14 and include all of the limitations of that base claim. As such, Claims 15-17 are felt to distinguish over IB.

Examiner's response:

c) Examiner strongly disagrees with applicant's assertion that IB fails to disclose the claimed limitations recited in claim 14. IB shows each and every limitation in claim 14. The Examiner has already addressed the applicant's arguments in the Examiner's Response (a) above. In addition, see the rejection above in paragraph 18 for rejection to claims 14-17.

In the remarks, the applicant argues that:

d) IB does not teach supplying a plug-in capable of interfacing with a third party legacy data list as required by the first limitation. IB describes a web browser (Netscape) plug-in that is capable of interfacing with the IB web server. That web server plug-in is not capable of

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interfacing with a third party legacy data list as required by the first limitation above. Moreover IB does not teach or suggests making identification and availability function call let alone responding the such function calls as required by the remaining limitations of Claim 21.

For these reasons, Claim 21 is felt to distinguish over IB. Claims 22-24 each depend from Claim 21 and include all of the limitations of that base claim. As such, Claims 22-24 are felt to distinguish over IB.

CLAIM 25: This fifth group is directed to a computer readable medium having a program or programs for carrying out a number of the method steps of Claim 2. For the reasons Claim 21 distinguishes over 1B so does Claims 25.

Examiner's response:

d) Examiner strongly disagrees with applicant's assertion that IB fails to disclose the claimed limitations recited in claim 21. IB clearly shows each and every limitation in claim 21. IB teaches supplying a plug-in module capable of providing an interface between the application program and the third party legacy data list; the application program sending a request function call to the plug-in module; the plug-in module, in response to the request function call, returning an identification of the third party legacy data list; the application program sending an availability function call to the plug-in module; and the plug-in module, in response to the availability function call, indicating whether or not the third party legacy data list is available (on pg. 1, par. 5, lines 1-6 and par. 6, lines 1-6; and pg. 3, par. 1, lines 1-7l; emphasis added).

In addition, see the rejection above in paragraph 18 for rejection to claims 21-25.

In the remarks, the applicant argues that:

e) IB does not describe a plug-in having the capabilities required by Claim 28. IB describes a web browser (Netscape) plug-in that is capable of interfacing with the IB web server. That web server plug-in is not capable of interfacing with a third party legacy data list as required by Claim 28. Moreover IB does not teach or suggest a program that is capable of making or responding to request, availability, or data function calls as required by Claim 28.

For these reasons, Claim 28 is felt to distinguish over IB. Claims 29-30 each depend from Claim 28 and include all of the limitations of that base claim. As such, Claims 29-30 are felt to distinguish over IB.

Examiner's response:

e) Examiner strongly disagrees with applicant's assertion that IB fails to disclose the claimed limitations recited in claim 28. IB shows each and every limitation in claim 28. The Examiner has already addressed the applicant's arguments in the Examiner's Responses (a) and (d) above. In addition, see the rejection above in paragraph 18 for rejection to claims 28-30.

In the remarks, the applicant argues that:

f) While it is not clear, it is assumed that the Examiner is equating nondescript software running on a facsimile server with the facsimile software of Claim 5. It is also assumed that the Examiner is equating the general data with the list of names and telephone numbers making up a legacy data list of Claim 5. Claim 5 has been amended to clearly indicate that the legacy facsimile software used to store the names and telephone numbers of a legacy data list) is

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different from the facsimile software that is the application program. The nondescript software running on Tsukamoto's facsimile server is more akin to the legacy facsimile software of Claim 5.

Neither IB or Tsukamoto, alone or in combination, teach an application program that is a facsimile software and a legacy data list that is a list of names and telephone numbers stored by a legacy facsimile software that is different than the facsimile software that is the application program. For this reason, Claims 5, 11, and 18 are felt to distinguish over the cited art.

Examiner's response:

f) Examiner strongly disagrees with applicant's assertion that the combination of IB and Tsukamoto fails to disclose the claimed limitations recited in claims 5, 11 and 18. The combination of IB and Tsukamoto clearly shows each and every limitation in claims 5, 11 and 18. Applicant failed to distinguish *in the claims* 5, 11 and 18 between the facsimile software as taught by Tsukamoto and the instant invention. Therefore, as broadly interpreted, Tsukamoto teaches the facsimile software and data list. In addition, see the rejection above in paragraph 20 for rejection to claims 5, 11 and 18.

In the remarks, the applicant argues that:

g) With reference to the second limitation, the Examiner cites Sampath, col. 6. lines 15-18. This section describes a billing database (connected to the server computer) that can contain an e-mail address. While not clear, it is presumed that the invoicing software on the server computer is responsible for storing the e-mail address in the billing database.

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Neither IB or Sampath, alone or in combination, teach an application program that is an e-mail software and a legacy data list that is a list of e-mail addresses stored by a legacy facsimile software that is different than the facsimile software that is the application program. For this reason, Claims 6, 12, and 19 are felt to distinguish over the cited art.

Examiner's response:

g) Examiner strongly disagrees with applicant's assertion that the combination of IB and Sampath fails to disclose the claimed limitations recited in claims 6, 12 and 19. The combination of IB and Sampath clearly shows each and every limitation in claims 6, 12 and 19. Applicant failed to distinguish *in the claims* 6, 12 and 19 between the email software as taught by Sampath and the instant invention. Therefore, as broadly interpreted, Sampath teaches the email software and data list. In addition, see the rejection above in paragraph 21 for rejection to claims 6, 12 and 19.

In the remarks, the applicant argues that:

h) Neither IB or Gottsman, alone or in combination, teach an application program that is a personal organizer software and a legacy data list that is contact information and appointment information stored using a legacy personal organizer software that is different than the facsimile software that is the application program. For this reason, Claims 7, 13, and 20 are felt to distinguish over the cited art.

Examiner's response:

h) Examiner strongly disagrees with applicant's assertion that the combination of IB and Gottsman fails to disclose the claimed limitations recited in claims 7, 13, and 20. The combination of IB and Gottsman clearly shows each and every limitation in claims 7, 13, and 20. Applicant failed to distinguish *in the claims* 7, 13, and 20 between the personal organizer software as taught by Gottsman and the instant invention. Therefore, as broadly interpreted, Gottsman teaches the personal organizer software and data list. In addition, see the rejection above in paragraph 22 for rejection to claims 7, 13, and 20.

Conclusion

24. In the claims, further clarification is needed regarding the plug-ins. That is, whether there is a one-to-one, one-to-many or many-to-one correspondence between the plug-ins and the third party data lists.

Furthermore, in the claims, further clarification is needed regarding the application program and the plug-ins. That is, whether there is a set of plug-ins for the application program itself or the plug-ins are available for any application program running on the computer system.

In addition, in the claims, further clarification is needed regarding querying an operating system. That is, querying the operating system, by looking for the plug-ins or the third party data list; how the plug-ins are identified as corresponding to the third party data lists.

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Thursdays from 8:30 AM to 6:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (571) 272-3719. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN

November 2, 2004



KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100